



30 JUN 2006

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In re Application of :
KINGSLAND et al. :
Application No.: 10/520,436 :
PCT No.: PCT/GB03/02928 :
Int. Filing: 07 July 2003 :
Priority Date: 10 July 2002 :
Attorney Docket No.: FDEHN7.002APC :
For: PROCESSED FOR THE PREPARATION :
OF FIBRINOGEN :

DECISION ON PETITION

This decision is issued in response to applicants' "Petition under 37 CFR 1.47(a)" filed 27 February 2006 to accept the application without the signature of joint inventor, Robert Clemmitt. The requisite \$200 petition fee has been submitted.

BACKGROUND

On 07 July 2003, applicants filed international application PCT/GB03/02928, which claimed a priority date 10 July 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 January 2004. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 10 January 2005.

On 05 January 2005, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 28 October 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 27 February 2006, applicants filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1) and (4) have been satisfied.

Regarding item (2) above, petitioner states that Robert Clemmitt cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

A review of the present petition reveals that applicants have not provided an acceptable showing that a diligent effort was made to reach the nonsigning inventor, Robert Clemmitt. The Declaration of Peter Feldman states that "I have made several unsuccessful attempts to reach Robert Clemmitt . . ." However, declarant has not provided documentary evidence to support the unsuccessful attempts. Were the numerous e-mails or letter dated 09 January 2006 returned as undeliverable? Further, it appears that the application papers were mailed to Mr. Clemmitt's corporate address. In this situation, the application papers should be submitted to the inventor at his last known home address to insure receipt. Lastly, applicant must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate the whereabouts of Mr. Clemmitt.

Regarding item (3) above, a clear statement of the last known address of the nonsigning inventor has not been provided. In situations where an inventor does not execute the oath or declaration, the inventor's most recent home address must be given to

Application No.: 10/520,436

enable the Office to communicate directly with the inventor as necessary. (See MPEP §605.03)

For the above reasons, it would not be appropriate to accept this application without the signature of Robert Clemmitt at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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